

REMARKS

The following issues are outstanding in the pending application:

- Claims 1-15 are re rejected under 35 USC 103.

Claim amendments

Claim 15 has been amended to more clearly define the subject invention. Claim 15 now recites a coffee brewing capsule containing a particulate coffee obtainable by a process that includes the steps of compressing a roasted coffee in a roller press having at least one roller with a pocketed surface for forming a compressed body of coffee; placing the compressed body of coffee into a sachet and sealing the sachet's edges; and crushing the compressed body of coffee in the sachet to form a particulate coffee product for placement in a brewing capsule. Claims 2-7, 11 and 13-14 have been amended to depend from claim 15. Claims 1, 8-10 and 12 have been cancelled. No new matter has been added.

35 USC § 103

Claims 1-15 are rejected under 35 USC 103(a) as having subject matter unpatentable over U.S. Pat. No. 5,853,788 to Murphy et al. in view of Perry et al. (Perry's Chemical Engineers' Handbook 7th Edition pages 20-82 through 20-84). Applicant respectfully traverses this rejection.

Murphy teaches a flowable roasted and ground coffee product that is in the form of aggregates of granular roasted and ground coffee particles having a maximum X50 particle size of 270 .mu.m. The dense coffee mass is formed by subjecting roasted coffee to grinding between a grinding roll and a die member while simultaneously forcing the coffee as it is being ground through a plurality of die orifices in the die member. As the coffee is forced through the die orifices, it is preferably periodically cut to provide discrete compacted particles or pellets of convenient size, suitably from 1.5 to 3.0 cm in length. The pellets are then ground to produce a densified roasted and ground coffee product having an X50 particle size of 270-1100 .mu.m and having the general appearance of roasted and ground coffee. The densified coffee product is thereafter packaged in conventional coffee packages.

Perry discloses that roll presses and pellets mills are both used to compress particulate materials together and form pellets. Roller presses can produce large quantities of material at a low cost.

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734-35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual inquiries enunciated therein for determining obviousness are: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims, explained below. Next, when ascertaining the differences between the prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and *all* claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. And finally, the test for obviousness requires identification of a reasonable basis for combining the claimed elements in the claimed fashion. *KSR*, 127 S. Ct. at 1741; M.P.E.P. §2143. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made.

Applying the proper test to this case begins with amended independent claim 15 that recites a coffee brewing capsule containing a particulate coffee obtainable by a process that requires the steps of compressing a roasted coffee in a roller press having at least one roller with a pocketed surface for forming a compressed body of coffee; placing the compressed body of coffee into a sachet and sealing the sachet's edges; and crushing the compressed body of coffee in the sachet to form a particulate coffee product for placement in a brewing capsule.

The prior art does not teach compressing a roasted coffee in a roller press to form a compressed body of coffee, placing the compressed body of coffee into a sachet and sealing the sachet's edges and then crushing the compressed body of coffee in the sachet to form a particulate coffee product. In Murphy the roasted coffee is ground between a grinding roll and a die member while simultaneously forcing the ground coffee through a plurality of die orifices in the die member to form discrete compacted particles or pellets. The pellets are then ground to produce a densified roasted and ground coffee product that is packaged in conventional coffee packages. Perry only teaches the use of roll presses to compress particulate materials together to form pellets.

In order to make a proper *prima facie* case for obviousness, all claim limitations must be accounted for. M.P.E.P. § 2143.03. This rejection fails to consider all elements of independent claim 15 their meaning. The cited references do not teach placing the compressed body of coffee into a sachet and sealing the sachet's edges and then crushing the compressed body of coffee in the sachet to form a particulate coffee product. In Murphy, the pellets are ground before being packaged in conventional coffee packages. Thus, claim 15 is erroneously rejected over the Murphy and Perry references and Applicant respectfully requests the rejection be removed.

If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of their dependency from independent claim 15, claims 2-7, 11 and 13-14 are nonobvious over these references. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 1-15 under 35 USC 103(a) as having subject matter unpatentable over U.S. Pat. No. 5,853,788 to Murphy et al. in view of Perry et al. (ed.) (Perry's Chemical Engineers' Handbook 7th Edition, pages 20-82 through 20-84).

CONCLUSION

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03144US0 from which the undersigned is authorized to draw.

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Respectfully submitted,

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